

REMARKS

Claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 are pending in the instant application. The Examiner has rejected claims 1-9 under 35 U.S.C. §101 as being allegedly directed to non-statutory material. The Examiner also rejected claims 1-9 under 35 U.S.C. §112, second paragraph as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Examiner further rejected claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 under 35 U.S.C. §102(e) as being as being allegedly unpatentable over U.S. Patent Publication No. 2002/0184111 to Swanson. Claims 1, 3, 34, and 35 have been amended as suggested by the Examiner to overcome the rejections under 35 U.S.C. §112, second paragraph. The Applicants traverse the remaining rejections under 35 U.S.C. §§101, 112, and 102(e) and submit that the instant application is in condition for allowance for at least the reasons presented below. No new matter has been entered.

Rejections under 35 U.S.C. §101

The Examiner states that claims 1-9 are non-statutory because the claims are "directed to neither a 'process' or a 'machine,' but rather embrace or overlap two different statutory classes of invention" (Page 2, item 3 of the Office Action dated August 24, 2005). The Examiner cites MPEP 2173.05(p) II or *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990) in support. The Applicants submit that the Examiner application of the teachings of *Lyell* to the instant application is improper. Applicants' claim 1 recites a system that includes "a server in communication with a workstation over a network, the workstation executing a design tool application; a bill of material assist application executing on at least one of the server and the workstation for managing said parts requirements processes". Thus, the system recited in claim 1 is classified as a machine and is proper statutory subject matter in accordance with 35 U.S.C. §101.

The Examiner's assertion that the claim recites overlapping statutory classes of subject matter (i.e., machine and process) is in error. The Court has held that "a computer operating pursuant to software may represent patentable subject matter, provided, of course, that the

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claimed subject matter meets all of the other requirements of title 35." *In re Alappat*, 33 F.3d 1526, 1545, 31 USPQ2d 1545 (Fed. Cir. 1994); see also *In re Lowry* 32 F.3d 1549, 32 USPQ2d 1031 (Fed.Cir. 1994). As recited, Applicants' claim 1 falls within a single statutory class, that is, a machine operating pursuant to software and accordingly, is patentable subject matter under 35 U.S.C. §101. The Applicants respectfully request reconsideration of the outstanding rejections.

Rejections under 35 U.S.C. §112, second paragraph

The Examiner has also rejected claims 1-9 under 35 U.S.C. §112, second paragraph, for the reasons set forth on page 3 of the Final Office Action of August 24, 2005. The Applicants submit that the rejections of claims 1-9 under 35 U.S.C. §112, second paragraph, are in error for at least the reasons presented above with respect to the rejections under 35 U.S.C. §101, and respectfully request reconsideration and withdrawal of the outstanding rejections.

In addition, the Applicants have amended claims 1, 3, 34, and 35 to overcome antecedent basis issues raised by the Examiner in the Office Action. The Applicants respectfully submit that claims 1, 3, 34 and 35 are in condition for allowance.

Rejections under 35 U.S.C. §102(e)

Claims 1-9, 11-15, 17-19, 21, 23-27, 29-31, and 33-35 have been rejected under 35 U.S.C. §102(e) as being allegedly anticipated by Swanson. With respect to independent claims 1, 34, and 35, the Applicants submit that these claims are patentable over Swanson because Swanson does not teach or suggest each and every element recited therein. In particular, Swanson neither teaches, nor suggests "a bill of material assist application...receiving a bill of material including a list of component parts in response to a product design conducted on the workstation." Swanson makes a generalized reference to a Bill of Material (paragraph 0067) but is entirely devoid of teaching "*receiving a bill of material...in response to a product design conducted on the workstation.*" In addition, Swanson fails to teach or disclose "mapping each component part in the list to corresponding part selection process information, the corresponding part selection process information acquired from a plurality of external sources." Rather Swanson teaches "bill of materials (BOM) and add-on information can be obtained" via a multi-media display window (FIG. 13) that displays product component information for a product that

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can be accessed, sorted, and filtered (paragraph 0107) but does not specifically teach “mapping each component part in the list to corresponding part selection process information...acquired from a plurality of external sources” as recited in Applicants’ claims 1, 34, and 35.

In addition, Swanson is devoid of teaching or suggesting “generating a summary resulting from the mapping” and “for each of the component parts in the list, the corresponding part selection process information includes...a current supply status.” The mapping, as recited in the claims, refers back to the component part in the list that results from the product design conducted, the component parts mapped to corresponding part selection process information. Swanson, by contrast, teaches a “report module must present the status of the data entry for each part” (paragraph 0082). If the Examiner is suggesting that the status of the data entry is equivalent to the summary resulting from the mapping, then this application of Swanson to the Applicants claims is in error. The Claims 1, 34, and 35 recite the summary generated as a result of the mapping, wherein the status of the data entry for each part refers to custom data entry processes (paragraph 0082).

Accordingly, the Applicants submit that claims 1, 34, and 35 are not anticipated by Swanson and respectfully request reconsideration and withdrawal of the outstanding rejections. Claims 2-9 depend from claim 1, claims 11-15, 17-19, and 21 depend from claim 34, and claims 23-27, 29-31, and 33 depend from claim 35. For at least these reasons, the Applicants submit that claims 2-9, 11-15, 1-19, 21, 21-27, 29-31, and 33 are in condition for allowance and respectfully request reconsideration and withdrawal of the outstanding rejections.

In view of the foregoing, it is respectfully submitted that the instant application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 50-0510.

Respectfully submitted,
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